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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/731,698   | 12/08/2000  | Kiyokazu Otsuka      | DP- 707 US          | 9689             |
| 466  | 7590        | 07/02/2004           | EXAMINER            |                  |
| YOUNG & THOMPSON<br>745 SOUTH 23RD STREET 2ND FLOOR<br>ARLINGTON, VA 22202 |             |                      | HSU, ALPUS          |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 2665                | 6                |

DATE MAILED: 07/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/731,698

Applicant(s)

OTSUKA, KIYOKAZU

Examiner

Alpus H. Hsu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3, 5.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.
2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "**means**" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

3. The drawings are objected to because the descriptions for elements 12 and 14 in Figures 1, 6-8, and elements 12a-12n and 14a-14n in Figure 10 were inconsistently labeled as "substitutive internal line"/ "internal line" or "substitutive internal line telephone"/ "internal line telephone" throughout the disclosure. Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified

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and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The disclosure is objected to because of the following informalities:

The elements 12 and 14 as in Figures 1, 6-8, and elements 12a-12n and 14a-14n as in Figure 10 were inconsistently described as “substitutive internal line”/ “internal line” or “substitutive internal line telephone”/ “internal line telephone” throughout the entire disclosure, which do not correspond to the drawing sheets either.

Appropriate correction is required.

5. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In each of claims 1-11, it is confusing for reciting “a telephone having an Internet Protocol (IP)” or “a private branch exchange having an Internet Protocol (IP)” since a telephone or a private branch exchange cannot have a “protocol”. Does it mean that a telephone or a private branch exchange conforming to an Internet Protocol (IP)?

Furthermore, in claim 1, line 5, “sending means for” should read as --sending means for sending--, line 13, “transmitting means for” should read as --transmitting means for transmitting -- for proper claim language. Similar changes should be applied to claims 2-11.

In claim 2, it is confusing for reciting “an internal line telephone” twice as in lines 6-7 and 18. Are they referring to the same device?

In claim 5, line 19, it is unclear as to what “and or” is referring to.

Claims 6-10 are rejected for the same reason as in claim 2.

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In claim 10, lines 26-27 and 31-32, same claim languages regarding the decrypting means were repeated which appeared to be redundant.

6. Claims 1-15 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

7. The following is an examiner's statement of reasons for allowance:

The subject matter of the claimed invention is allowable over the prior art of record because all prior arts fail to disclose or suggest an internal line control system, providing a telephone conforming to an Internet protocol (IP) and capable of being connected to the Internet through the communication mode, comprising a storage means for an IP address of a private branch exchange (PBX) and a sending means for a switching request to the IP address of the PBX while specifying identification information of an internal line telephone of which switching is requested, accommodated in the PBX, and the PBX is also conforming to the Internet protocol (IP) and connected to the Internet through the communication mode, and comprising a storage means for a correlation between the IP address of the telephone and an internal line number depending upon the identification information and a transmitting means for transmitting a control signal and a speech communication signal for an internal line telephone of the internal line number to an address specified by the IP address.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


Chang et al., Vaziri et al., Schuster et al. and Chen are all cited to show the common feature of internet telephony communication utilizing mapping of telephone number and IP address similar to the claimed invention.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alpus H. Hsu whose telephone number is (703)305-4377. The examiner can normally be reached on M-F (5:30-3:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy D. Vu can be reached on (703)308-6602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AHH



Alpus H. Hsu  
Primary Examiner  
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